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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/717,028	11/18/2003	Bo Li	H9930-0305	7345

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EXAMINER

JOHNSON, CONNIE P

ART UNIT	PAPER NUMBER
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1752

DATE MAILED: 05/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/717,028	LI ET AL.	
	Examiner	Art Unit	
	Connie P. Johnson	1752	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-51, 53, 55 and 56 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-51, 53, 55 and 56 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The amendment, remarks and declaration filed on March 16, 2006 have been entered and fully considered.
2. The objections 1 and 2 to the specification are withdrawn. Since objections 3 and 4 are not addressed in Applicants' remarks, the objections are maintained.
3. The 112, second paragraph rejections are maintained.
4. Claims 1-51, 53 and 55-56 are pending.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 2, 44, 46 and 48 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The aforementioned claims do not specify which components comprise the composition. It is unclear as to whether all of the components of claim 2 need to be in the composition to meet the requirements of the material modification agent.

Double Patenting

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re*

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Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 1-22, 24, 26, 27, 28, 29, 30, 31, 32, 33, 34, 35, 37, 38, 39, 41-51, 53, 55, 56 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7, 9-20 and 22-29 of Kennedy et al., U.S. Patent No. 6956097 B2. Although the conflicting claims are not identical, they are not patentably distinct from each other because both the application and the patent contain an absorbing compound, an inorganic compound and a material modification agent.

9. Claims 1-22, 24, 26, 27, 28, 29, 30, 31, 32, 33, 34, 35, 37, 38, 39, 41-51, 53, 55, 56 are rejected under 35 U.S.C. 103(a) as being obvious over Kennedy et al., U.S. Patent No. 6956097 B2.

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the

reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(l)(1) and § 706.02(l)(2).

10. Claims 1-14, 16-22, 26, 28, 31, 32, 33, 34, 35, 37, 38, 39, 41-51, 53, 55, 56 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-19 of Kennedy et al., U.S. Patent Publication No. US 2002/0055000 A1. Although the conflicting claims are not identical, they are not patentably distinct from each other because both the application and the patent contain an absorbing compound, an inorganic compound and a material modification agent.

11. Claims 1-14, 16-22, 26, 28, 31, 32, 33, 34, 35, 37, 38, 39, 41-51, 53, 55, 56 are rejected under 35 U.S.C. 102(e) as being anticipated by Kennedy et al., U.S. Patent Publication No. US 2002/0055000 A1.

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the

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reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Claim Rejections - 35 USC § 102

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

13. Claims 1, 7, 11, 12, 13, 16, 17, 18, 19, 20, 21, 26, 29, 30, 31, 32, 33, 41 and 42, are rejected under 35 U.S.C. 102(e) as being unpatentable by Ravichandran et al., U.S.

Patent No. 6,677,392 B2.

Ravichandran et al. teaches an absorbing composition consisting of an inorganic compound, an absorbing compound and a material modification agent (Column 9, lines 50-59 and column 10, lines 55-67). The absorbing compounds include an epoxy carboxy resin and a silane modified acrylic melamine (column 10, line 9) as claimed in instant claim 7. In addition, when water-soluble, water miscible or water dispersible coatings are preferred, ammonium salts of acid groups present in the resin are formed. For example, a powder coating composition can be prepared by reacting glycidyl methacrylate with selected alcohol components (column 23, lines 49-53). Claims 19, 20

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and 21 include an adhesion promoter comprises an amine base (column 19, no. 9), ammonium and an amine salt (column 23, lines 49-52). Ravichandran et al. teaches silicon oxide as an inorganic compound used in combination with polysiloxanes and other activators and ligands as a stabilizer in the polymer composition (column 12, lines 20-41). Claims 11,12 and 13 include inorganic, silicon-based polymer compounds including polysiloxanes. Ravichandran et al. also teaches amines (column 19, no.9), nitrones (column 19, no. 7) and phosphites (column 19, no. 4) as stabilizers used in the composition as in instant claims 16, 17, 18 and 19 claim the same. In reference to claims 29 and 30, crosslinked polymers such as phenol/formaldehyde resins and epoxy acrylates are also used as stabilizers in the composition (column 14, no. 21 and 24). Ravichandran et al. teaches adhesion promoters used in polymerization includes dialkoxysilanes, trialkoxysilanes and other similar silane intermediates (column 27, lines 56-61) as in instant claims 31, 32 and 33.

14. Claims 1 and 36 are rejected under 35 U.S.C. 102(a) as being unpatentable by WO 03/088344 A1.

Leung et al. teaches all of the limitations of instant claim 1, including an inorganic based component at least one absorbing compound, one material modifier and a porogen, which is selected from a group including polyalkylene oxides (page 15, lines 25-29). In reference to claim 36, a polyethylene oxide is one porogen contained in the group of polyalkylene oxides. The polyethylene oxide is disclosed at page 15, line 27 of the reference.

Response to Arguments

15. Applicant's arguments filed March 16, 2006 have been fully considered but they are not persuasive.

16. Applicant did not amend claims 2, 44, 46 and 48 for clarification of the components of the composition. Applicant cites in the remarks that the claims are clear and concise with regards to the components of the composition. Examiner disagrees. The "at least" language implies that the composition must comprise "at least" one of each component. Therefore the rejections are maintained.

17. The specification was submitted in its entirety on November 18, 2003 and again on March 16, 2006. Since the examples were included with the specification that was submitted on November 18, 2003, objections 1 and 2 from the previous office action are withdrawn. The examples were given full consideration during examination, however after further review, the examples provided do not add any patentable weight to the claims.

18. Applicant does not present any arguments with respect to the prior art of record, therefore the rejections are maintained.

Conclusion

19. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the


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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Connie P. Johnson whose telephone number is 571-272-7758. The examiner can normally be reached on 7:30am-4:00pm Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 571-272-1526. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


AMANDA WALKER
PRIMARY EXAMINER


Connie P. Johnson
Examiner
Art Unit 1752